

## **REMARKS**

Claims 1-3 and 5-20 are pending in the application. In the Office action dated July 25, 2007, claims 1-3, 5-10, 12-16, and 18-20 were rejected under 35 U.S.C. § 103(a); claim 11 was rejected under 35 U.S.C. § 103(a); and claim 17 was rejected under 35 U.S.C. § 103(a). In view of the following amendments and remarks, Applicants respectfully request reconsideration of the claims under 37 C.F.R. § 1.111.

### ***Telephonic Interview***

Applicants are grateful to the Examiner for the courtesy of a telephonic interview on November 26, 2007. The undersigned agent, Examiner Hylinski, and her supervisory Examiner Kim participated in the interview.

The participants discussed how best to distinguish the claimed invention over the Goldfarb '492 reference, including proposed amendments to more particularly define the invention.

### ***Rejections under 35 U.S.C. § 103***

Claims 1-3, 5-10, 12-16, and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods (U.S. Patent no. 6,152,298; hereafter Dods '298), Lapides (U.S. Patent no. 3,173,540), and Goldfarb et al. (U.S. Patent no. 6,287,492; hereafter Goldfarb '492).

In particular, the Examiner asserts that it would have been obvious to one of ordinary skill in the art from the teaching of Lapides to include an aperture in the backing sheet of Dods '298 in order to not hinder a potential purchaser's view of the item while still in the packaging. Furthermore, the Examiner alleges it would have been obvious to one of ordinary skill in the art from the teaching of Goldfarb to modify the panel of Dods '298 to incorporate a lithophane-type panel in order to create a visually interesting display. Applicants respectfully disagree.

The pending claims are directed to packaged toys and toy sets that include lithophane panels. Applicants respectfully suggest that the Goldfarb '492 reference fails to disclose a lithophane panel, instead disclosing "lithophane-type pictorial works" that are produced by pressing a translucent and pliable material, such as PLAY-DOH modeling clay (see col. 3, line 66 to col. 4, line 20; and col. 6, lines 1-6), against a contoured surface that features a negative, or "reverse image" of the desired lithophane-type pictorial work.

Where Goldfarb '492 describes a formed lithophane-type pictorial work, such as in combination with the toy of Figure 20 it is understood to be a temporary and freshly made sheet formed from a pliable material that is easily further deformed. Applicants suggest that Goldfarb et al. fails to disclose a toy set where a toy and a distinct lithophane panel are packaged in such a way that the lithophane panel may be viewed when back-lit.

However, in the interest of furthering the prosecution of the application, Applicants have amended claims 1, 5, and 18 to more particularly define the claimed invention. Specifically, Applicants have recited that the claimed lithophane panel includes a plate of translucent material having a surface shaped so that when the plate is backlit the depicted image is formed by a differential thickness of the plate. Support for the amendments may be found in the specification generally as filed, and more specifically at paragraph 0003.

Applicants additionally take this opportunity to amend claim 1 to recite that the image depicted by the lithophane panel may be viewed when backlit through an aperture in the packaging. Support for the amendment is found in claims 5 and 18 as originally filed.

Applicant suggests that the cited references, considered separately or in combination, fail to disclose a lithophane panel depicting an image, as recited in the amended claims. Furthermore, the cited references fail to provide a motivation to modify the cited references so as to arrive at

the claimed invention.

The Dods '298 reference fails to discuss the inclusion of a lithophane panel, but *requires* the inclusion of a trading card, with information printed on the front and rear surfaces. Goldfarb et al. fail to disclose any lithophane panels, and fail to provide a motivation for separately packaging their disclosed "lithophane-type pictorial works". As Goldfarb et al. is directed to apparatus for the *preparation* of such lithophane-type pictorial works, and not their sale or display, Applicants suggest that modifying the teaching of Goldfarb et al. as suggested by the Examiner would change the principle of operation of the Goldfarb et al. apparatus.

For at least these reasons, Applicants respectfully suggest that the cited references fail to establish the *prima facie* obviousness of the pending claims, as amended. In view of the above amendments and remarks, Applicants respectfully request the withdrawal of the rejection of claims 1-3, 5-10, 12-16, and 18-20 under 35 U.S.C. § 103(a).

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods '298, Lapides, and Goldfarb et al. '492. Claim 11 depends from independent claim 5. Applicants suggest that the cited references fail to establish the *prima facie* obviousness of the invention of claim 11 for at least the reasons provided above for claim 5. Applicants therefore respectfully request the withdrawal of the rejection of claim 11 under 35 U.S.C. § 103.

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dods, Lapides, Goldfarb et al. and Mickelberg (U.S. Patent no. 5,289,916). Claim 17 depends from independent claim 5. Applicants suggest that the cited references fail to establish the *prima facie* obviousness of the invention of claim 17 for at least the reasons provided above for claim 5. Applicants therefore respectfully request the withdrawal of the rejection of claim 17 under 35 U.S.C. § 103.

In view of the above amendments and remarks, Applicants believe that the instant application is in condition for allowance. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

CERTIFICATE OF E-FILING

I hereby certify that this correspondence is being transmitted electronically via the United States Patent and Trademark Office's EFS-Web System on November 26, 2007.

Allison M. Deverman Vietor

Allison M. Deverman Vietor

Respectfully submitted,

KOLISCH HARTWELL, P.C.

Anton E. Skaugset

Anton E. Skaugset

Registration No. 38,617

Customer No. 23581

Attorney/Agent for Applicant(s)/Assignee

520 S.W. Yamhill Street, Suite 200

Portland, Oregon 97204

Telephone: (503) 224-6655

Facsimile: (503) 295-6679